



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,531	01/26/2001	Naohito Takae	1095.1155 (JDH)	4909

21171 7590 09/12/2003

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary

Application No.

09/769,531

Applicant(s)

TAKAE ET AL.

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-5, 7, 8, 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Keiko et al (JP: 2001-245050).

For claims 1, 7, 11, Keiko et al teach on Fig. 1-3 and paragraph 20-34 telephone number changing means to change a number in response to a request to a telephone directory of a registrant who's phone number has been registered in the phone number changer's directory.

Regarding claims 2, 3, all rejections as stated in claim 1 above apply.

Art Unit: 2645

Keiko et al teach on paragraph 23-26 and Fig. 6 extracting registrants information for sending a change notification.

Regarding claims 4, 5, Keiko et al teach on Fig. 17 means for confirming in advance before modification.

Regarding claim 8, Keiko et al teach on paragraph 26 the step 6 of Fig. 3 generating the change notification by item 5 of Fig.1 (claimed "portable telephone service provider").

Regarding claim 10, Keiko et al teach on Fig. 8 means for reflecting telephone number difference.

Regarding claim 12, all rejections as stated in claims 1-5, 7, 8, 10, 11 above apply.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2645

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiko et al as applied in claim 1 above, and in view of Kyu (JP: 411331353). Keiko et al failed to teach “specify a time at which the telephone number change is to be performed”. However, Kyu teaches on Abstract – a schedule table (reads on claimed “specify a time”) for editing telephone directory. It would have been obvious to one skilled at the time the invention was made to modify Keiko et al to have the “specify a time at which the telephone number change is to be performed” as taught by Kyu such that the modified system of Keiko et al would be able to support the specifying a time for changing the telephone number to the system users.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiko et al as applied in claim 8 above, and in view of Lautenschlager et al (US: 6289091). Keiko et al failed to teach “said telephone.....service provider”. However, Lautenschlager et al teach on Abstract – the directory number administration (reads on claimed “telephone service provider”) issues the change order and synchronizes the changes to the subscriber terminal (claimed “number changer”). It would have been obvious to one skilled at the time the invention was made to modify Keiko et al to have the “said telephone.....service provider” as taught by Lautenschlager et al such that the modified system of Keiko et al would be able to support the notification instruction from the service provider to the system users.

Conclusion

Art Unit: 2645

4. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Smith Jr. et al (US: 6603839) teach automatic transfer of electronic directory entries from directory service to a directory within an electronic device.

5. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

